

REMARKS

Applicant files concurrently herewith a Request for Continued Examination (RCE) in response to the final Office Action mailed October 2, 2009 (hereinafter, "Office Action"). In the Office Action, the Examiner rejected claims 1, 21, and 38-40 under 35 U.S.C. § 112, first and second paragraph; rejected claims 1-3, 7, 9, 11, 15-21, 26, 28, 30, 38, and 39¹ under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0061093 to Todd (hereinafter, "Todd") in view of U.S. Patent Application Publication No. 2003/0171992 to Blagg et al. (hereinafter, "Blagg"); rejected claims 4-6 and 23-25 under 35 U.S.C. § 103(a) as being unpatentable over Todd in view of Blagg and in further view of U.S. Patent Application Publication No. 2005/0021457 to Johnson (hereinafter, "Johnson"); rejected claims 14 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Todd in view of Blagg and in further view of U.S. Patent No. 5,991,750 to Watson (hereinafter, "Watson"); rejected claim 40 under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Todd and Blagg; and rejected claims 13, 32, and 41-43 under 35 U.S.C. § 103(a) as being unpatentable over Todd and Blagg in view of U.S. Patent No. 5,949,044 to Walker et al. (hereinafter, "Walker").²

¹ At page 2 of the Office Action, the Examiner states that claims 1-3, 7-11, 15-21, 26-30, 38, and 39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Todd in view of Blagg. See also Office Action Summary, items 4 and 6. However, Applicant respectfully notes that claims 10, 27, 29 were previously canceled by amendment. Therefore, Applicant believes the rejection should state that claims 1-3, 7, 9, 11, 15-21, 26, 28, 30, 38, and 39 are rejected under § 103(a) over Todd in view of Blagg, and Applicant responds herein accordingly.

² Applicant notes that the Office Action does not reflect any rejections for claims 22 and 34. Accordingly, Applicant has not been provided with a meaningful opportunity to respond to any rejection of these claims.

By this Amendment, Applicant amends claims 1, 13, 21, and 38-41. In addition, Applicants cancels claims 14 and 32, without prejudice or disclaimer of their subject matter, incorporating the subject matter of claim 14 into new claim 44 and the subject matter of claim 32 into new claim 45. No new matter has been added. Claims 8, 10, 12, 27, 29, and 31 were previously canceled. Accordingly, claims 1-7, 9, 11, 13, 15-26, 28, 30, and 32-45 are pending and under current examination.

In light of the foregoing amendments and based on the reasoning presented below, Applicant respectfully traverses the rejections of claims under 35 U.S.C. §§ 103(a) and 112, first and second paragraphs, and requests allowance of pending claims 1-7, 9, 11, 13, 15-26, 28, 30, and 32-45.

I. Rejections under 35 U.S.C. § 112, First Paragraph

In the Office Action, the Examiner rejected claims 1, 21, and 38-40 for allegedly "failing to comply with the written description requirement." Office Action, p. 2. Specifically, the Examiner stated that "[t]he specification does not teach *configuring the first financial account to provide a first incentive when less than a threshold quantity of transactions are performed using the second financial account* and *configuring the first financial account to provide a second incentive[] when more than the threshold quantity of transactions are performed using the second financial account*, wherein the first incentive is more attractive than the second incentive." *Id.* at p. 3 (emphasis and italics in original).

Applicant respectfully disagrees with the Examiner's characterization of the claims as lacking written description in the specification. M.P.E.P. § 608.01(o) states, "[t]he meaning of every term used in any of the claims should be apparent from the

descriptive portion of the specification with clear disclosure as to its import." Further, "[t]here is no requirement that the words in the claim must match those used in the specification disclosure." M.P.E.P. § 2173.05(d).

While Applicant asserts that the meaning of the recitations of claims 1, 21, and 38-40 are apparent from the specification, to advance prosecution, Applicant has nevertheless amended independent claim 1 to recite, *inter alia*, "configuring the first financial account to provide, via a computer system associated with the first financial account provider, a first incentive when a first subset of transactions are performed using the first financial account" and "configuring the first financial account to provide, via the computer system, a second incentive when a second subset of transactions are performed using the second financial account . . ." Independent claims 21 and 38-40, although of different scope, have been similarly amended. Support for the amendments can be found in the specification at, for example, paragraphs [039] - [049] and Table 3.

Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 1, 21, and 38-40 under 35 U.S.C. § 112, ¶ 1.

II. Rejections under 35 U.S.C. § 112, Second Paragraph

In the Office Action, the Examiner rejected claims 1, 21, and 38-40 as allegedly "being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Office Action, p. 4. In particular, the Examiner stated that "[i]t is unclear what Applicant is referring to by configuring the first financial account to provide a first incentive[] and configuring the first account to provide a second incentives." Id. The Examiner continued, stating that "[a]n account does not

provide an incentive, a provider of the account is the one that provides the incentive."

Id.

While Applicant respectfully disagrees with the Examiner's characterization of claims 1, 21, and 38-40, to advance prosecution, Applicant has nevertheless amended the claims. In particular, Applicant has amended claim 1 to recite, *inter alia*, "configuring the first financial account to provide, via a computer system associated with the first financial account provider, a first incentive when a first subset of transactions are performed using the first financial account" and "configuring the first financial account to provide, via the computer system, a second incentive when a second subset of transactions are performed using the second financial account . . ." Claims 21 and 38-40, although of different scope, have been similarly amended.

Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 1, 21, and 38-40 under 35 U.S.C. § 112, ¶ 2.

III. Rejections under 35 U.S.C. § 103(a)

Applicant respectfully traverse the rejection of 1-7, 9, 11, 13, 15-26, 28, 30, and 33-45 under 35 U.S.C. § 103(a) as being unpatentable over the cited art. Claim 14 has been canceled; however, the subject matter of claim 14 has been included in new claim 44, and the subject matter of claim 32 has been included in new claim 45.

The key to supporting any rejection under 35 U.S.C. § 103(a) is the clear articulation of the reasons why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See M.P.E.P. § 2141, 8th Ed., Rev. 6 (Sept. 2007). Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant

combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III) (internal citations omitted). In addition, when "determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(I) (internal citations omitted) (emphasis in original).

A. Claims 1-3, 7, 9, 11, 15-21, 26, 18, 30, 38, and 39

Here, the cited prior art fails to disclose or suggest, *inter alia*, "configuring the first financial account to provide, via a computer system associated with the first financial account provider, a first incentive when a first subset of transactions are performed using the first financial account" and "configuring the first financial account to provide, via the computer system, a second incentive when a second subset of transactions are performed using the second financial account . . . , as recited in amended independent claim 1, and similarly recited in amended independent claims 21, 38, and 39.

Todd discloses a system for rewarding customers of a financial service provider "based on transactions completed using services of the financial service provider. Todd, ¶ [0033]. Todd further teaches allowing one customer to transfer rewards to the account of another customer. Id. Todd does not, however, teach the above quoted-recitations of Applicant's claim 1. Indeed, in the Office Action, the Examiner states that

Todd does not specifically disclose:

- *configuring the first financial account to provide a first incentive when less than a threshold quantity of transactions are performed using the second financial*

account and configuring the first financial account to provide a second incentives when more than the threshold quantity of transactions are performed using the second financial account, wherein the first incentive is more attractive than the second incentive.

Office Action, p. 5 (emphasis and italics in original).

Blagg fails to overcome the deficiencies of Todd, as discussed above, including the failure of Todd to disclose or suggest the above-quoted claim recitations. According to the Examiner, “Blagg . . . discloses . . . a method for processing rewards by identifying a reward type and providing an earning rule that is associate with the reward type.” Office Action, p. 5. Further, the Examiner states that “[t]he earning rule [] indicates that the reward of the reward type is earned at a first rate when an activity is performed in relation to an account group (first account), and a second rate when an activity is performed in relation to an individual account (second account).” *Id.*

While Applicant does not concede the Examiner’s characterizations regarding Blagg, such teachings do not correspond to Applicant’s claim recitations including, *inter alia*, “configuring the first financial account to provide, via a computer system associated with the first financial account provider, a first incentive when a first subset of transactions are performed using the first financial account” and “configuring the first financial account to provide, via the computer system, a second incentive when a second subset of transactions are performed using the second financial account . . . ,” as recited in amended independent claim 1, and similarly recited in amended independent claims 21, 38, and 39. Further, no other portion of Blagg discloses or suggests these recitations.

Accordingly, neither Todd, nor Blagg, discloses or suggests at least the above-quoted elements of amended independent claim 1. Therefore, amended independent claim 1 is nonobvious over Todd and Blagg under 35 U.S.C. § 103(a), and should be allowed.

Amended independent claims 21, 38, and 39, although different in scope, include recitations similar to those of amended independent claim 1. Accordingly, for at least the same reasons as set forth above in connection with amended independent claim 1, Todd and Blagg also fail to disclose or suggest the recitations of amended independent claims 21, 38, and 39. Therefore, amended independent claims 21, 38, and 39 are also nonobvious over Todd and Blagg under 35 U.S.C. § 103(a), and should be allowed.

Claims 2-3, 7, 9, 11, and 15-20 depend from amended independent claim 1. Claims 26, 28, and 30 depend from amended independent claim 21. For at least the same reasons as set forth above in connection with their corresponding independent claims, 2-3, 7, 9, 11, 15-20, 26, 28, and 30 are also nonobvious over Todd and Blagg under 35 U.S.C. § 103(a), and should be allowed.

B. Claims 4-6, 13, 23-25, 33, and 41-45

Claims 4-6, 13, 34, 41, and 44 depend from amended independent claim 1. Claims 23-25, 33, 42, and 45 depend from amended independent claim 21. Claim 43 depends from amended independent claim 38. By virtue of their respective dependence from amended independent claims 1, 21, and 38, claims 4-6, 13, 23-25, 33, and 41-45 requires a combination including, *inter alia*, "configuring the first financial account to provide, via a computer system associated with the first financial account provider, a first incentive when a first subset of transactions are performed using the

first financial account" and "configuring the first financial account to provide, via the computer system, a second incentive when a second subset of transactions are performed using the second financial account . . . , as recited in amended independent claim 1, and similarly recited in amended independent claims 21, 28, and 39.

Neither Johnson, nor Watson, nor Walker, overcome the deficiencies of Todd and Blagg, as discussed above, at least because Johnson, Watson, and Walker also fail to disclose or suggest at least the above-quoted recitations of amended independent claim 1. The Examiner cites Johnson as disclosing "receiving a forecast goal and determining if the forecast goal is met and applying an incentive to the first account when the forecast goal is met." Office Action, p. 7. The Examiner cites Watson as disclosing "wherein the user give authorization to transfer transactions." Id. at p. 8. Further, the Examiner cites Walker as teaching, for example, "providing a payment for the second financial account transactions . . . and adding a total transaction amount . . . to a balance associated with the first financial account." Id. at p. 10.

While Applicant does not concede the Examiner's statements regarding Johnson, Watson, and Walker, such teachings do not correspond to Applicant's claim recitations including, *inter alia*, "configuring the first financial account to provide, via a computer system associated with the first financial account provider, a first incentive when a first subset of transactions are performed using the first financial account" and "configuring the first financial account to provide, via the computer system, a second incentive when a second subset of transactions are performed using the second financial account . . . , as recited in amended independent claim 1, and similarly recited in amended

independent claims 21, 28, and 39. Further, no other portions of Johnson, Watson, or Walker disclose or suggest these recitations.

Therefore, amended independent claims 1, 21, 28, and 39, and claims 4-6, 13, 23-25, 33, and 41-45 that depends therefrom, should be patentable over Todd, Blagg, Johnson, Watson, or Walker.

C. Claim 40

Claim 40 stands rejected under § 103(a) as being unpatentable over Johnson, Todd, and Blagg. Applicant submits that neither Johnson, nor Todd, nor Blagg, whether taken alone or in combination, teach or suggest the recitations of amended independent claim 40, including the claim 40 recitations of "configuring the first financial account to provide, via the computer, a first incentive when a first subset of transactions are performed using the first financial account" and "configuring the first financial account to provide, via the computer, a second incentive when a second subset of transactions are performed using the second financial account, wherein the first incentive is more attractive than the second incentive."

In the Office Action at page 9, the Examiner acknowledges that neither Johnson, nor Todd, disclose or suggest at least these recitations, stating

The combination of Johnson/Todd does not specifically disclose:

- *configuring the first financial account to provide a first incentive when less than a threshold quantity of transactions are performed using the second financial account and configuring the first financial account to provide a second incentives when more than the threshold quantity of transactions are performed using the second financial account, wherein the first incentive is more attractive than the second incentive.*

Instead, the Examiner relies on Blagg. However, Blagg fails to overcome the deficiencies of Johnson and Todd, as discussed above, including the failure of Johnson and Todd to disclose or suggest the above-quoted claim recitations. According to the Examiner, "Blagg . . . discloses . . . a method for processing rewards by identifying a reward type and providing an earning rule that is associate with the reward type." Office Action, p. 9. Further, the Examiner states that "[t]he earning rule [] indicates that the reward of the reward type is earned at a first rate when an activity is performed in relation to an account group (first account), and a second rate when an activity is performed in relation to an individual account (second account)." Id.

While Applicant does not concede the Examiner's statements regarding Blagg, such teachings do not correspond to Applicant's claim recitations including, *inter alia*, "configuring the first financial account to provide, via a computer system associated with the first financial account provider, a first incentive when a first subset of transactions are performed using the first financial account" and "configuring the first financial account to provide, via the computer system, a second incentive when a second subset of transactions are performed using the second financial account . . . , as recited in amended independent claim 40. Further, no other portion of Blagg discloses or suggests these recitations.

Accordingly, neither Johnson, nor Todd, nor Blagg, discloses or suggests at least the above-quoted elements of amended independent claim 40. Therefore, amended independent claim 40 is nonobvious over Johnson, Todd, and Blagg under 35 U.S.C. § 103(a), and should be allowed.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicant submits that this claimed invention is neither anticipated nor rendered obvious in view of the cited art. Applicant therefore requests reconsideration and reexamination of this application, and the timely allowance of the pending claims.

In addition, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statements are identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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